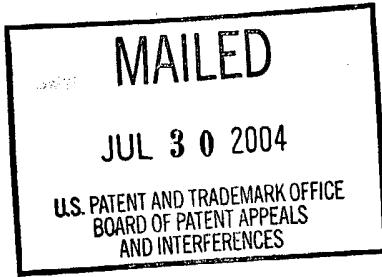


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte NORMAN PAUL FORMO

Appeal No. 2004-0996
Application No. 09/520,947

ON BRIEF

Before WALTZ, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 25 through 35, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a method of providing a double package for pre-sliced loaves of bread having a tight, neat inner package and an outer bag, as well as the double package of bread itself (Brief, page 2). Further details of the invention may be gleaned from independent claims 25 and 32 reproduced below:

25. A method for packaging a loaf of bread, which method comprises:

feeding the loaf through an open first end of an inner preformed bag having a closed second end opposite the first end, the closed second end of the inner preformed bag having bag-weakening opening means for enabling access to the loaf by a consumer through the second end of the inner bag;

closing the first end of the inner bag and heat shrinking the inner bag to closely encircle the loaf;

inserting the heat shrunk inner bag and enclosed loaf endwise, second end last, through an open end of a preformed outer bag which outer bag has a closed end opposite the open end, the open end of the outer bag being configured for closing and for reopening by a consumer, but the closed end of the outer bag not being configured for opening by a consumer; and

closing the open end of the outer bag such that the bag-weakening opening means is presented to a consumer upon reopening of the open end of the outer bag, without providing bag-weakening opening means in the closed end of the outer bag and without exposing the first end of the inner preformed bag at the reopened end of the outer bag.

32. A packaged product comprising a loaf of bread snugly enclosed in an inner heat shrunk bag having a preformed closed end and a gathered, previously open end opposite the preformed closed end, such heat shrunk inner bag and enclosed loaf being contained within a separate outer bag having a closed first end and an openable second end, the preformed closed end of the heat shrunk inner bag being adjacent to the openable end of the outer bag and such closed end of the heat shrunk inner bag having bag-weakening means for manual opening of the inner bag by a consumer, the second end of the outer bag being configured for opening by a consumer but the closed first end of the outer bag not being configured for opening by a consumer, and the inner bag being disposed within the outer bag with the preformed closed end of the inner bag adjacent to the openable second end of the outer bag and the gathered end of the inner bag remote from the openable second end of the outer bag.

Appeal No. 2004-0996
Application No. 09/520,947

The examiner has relied upon the following references as evidence of obviousness:

Blum	2,132,144	Oct. 04, 1938
Morris	3,428,240	Feb. 18, 1969
Collins et al. (Collins)	5,741,075	Apr. 21, 1998
McEachen	243745 A	Aug. 27, 1996
(published New Zealand Patent Application)		
Theed	2 331 059 A	May 12, 1999
(published UK Patent Application)		

The following rejections are before us for review in this appeal:

- (1) claims 25, 26 and 30-34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Morris in view of McEachen and Theed (*Answer*, page 3);
- (2) claim 27 stands rejected under § 103(a) over Morris in view of McEachen, Theed and Collins (*id.*);
- (3) claims 28 and 35 stand rejected under § 103(a) over Morris in view of McEachen, Theed and Blum (*id.*); and
- (4) claim 29 stand rejected under § 103(a) over Morris in view of McEachen, Theed, Collins and Blum (*id.*).

We reverse all of the rejections on appeal essentially for the reasons stated in the Brief, Reply Brief, and those reasons set forth below.

OPINION

The examiner finds that Morris teaches placing a loaf of bread in an inner package (a wax paper wrapper) that has one end with a weakening opening means (i.e., perforations) for enabling access to the loaf by the consumer, inserting the inner package into an outer bag such that the end of the inner package with the weakening opening means is inserted last, and closing the outer bag (Answer, page 4; see also the final Office action, Paper No. 8, pages 2-3). The examiner recognizes that Morris fails to teach two limitations recited in claim 25, i.e., where the bread loaf is fed into a bag having a closed end with a weakening opening means and heat shrinking the inner bag (Answer, page 4; Paper No. 8, page 3). The examiner relies on McEachen "as evidence of the conventionality of enclosing a loaf of bread in a bag with a closed end having a weakening means (i.e. perforations) and an open end for filling where the weakening means allow the consumer to access the bread after the package has been sealed" (Paper No. 8, page 3). The examiner further relies on Theed "as evidence of the conventionality of heat shrinking an inner bag of a double bag bread package to preserve the bread" (Paper No. 8, page 4).

From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art to modify the

Appeal No. 2004-0996
Application No. 09/520,947

method of Morris to include the step of inserting the loaf of bread into the bag of McEachen while heat shrinking this inner bag to seal the bread to maintain freshness (Paper No. 8, pages 3-4). We disagree.

"When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification. [Citations omitted]." *In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. [Citations omitted]." *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In view of these tenets of patent law, we determine that the examiner has not established the obviousness of "substituting" an inner bag for the inner wrapper of Morris, nor established the obviousness of heat shrinking the inner bag.

Appeal No. 2004-0996
Application No. 09/520,947

Morris teaches a bread package which uses an inner wrap of waxed paper including sealed end flaps and perforations around the periphery, enclosed in an outer plastic bag (abstract; col. 1, l. 70-col. 2, l. 10; and col. 3, ll. 3-8). Morris discusses the prior art use of wrapper-type and bag-type bread packaging and states (col. 1, ll. 65-68)

The principal object of the present invention is to provide a novel bread package effective to combine the best features of both wrapper-type and bag-type bread packages.

Accordingly, the examiner has not provided nor established, by technical reasoning or objective evidence, any convincing showing why one of ordinary skill in this art would have "substituted" a preformed bag for the inner wrapping of Morris. McEachen does not provide this evidence as this reference is directed to bread packaging involving only one bag with at least one line of partial weakness distal from the closed end (McEachen, page 3). We find no support for the examiner's finding that the sole bag taught by McEachen has an "equivalent function" as the inner wrapping of Morris, i.e., "a sealed bread package with a weakening opening means," thus providing motivation for the proposed "substitution" (Answer, paragraph bridging pages 4-5). As taught by Morris and correctly argued by appellant (Brief, page 10), the function of the inner wrap is "that the loaf is firmly maintained in its

original conformation" (col. 2, ll. 12-14), while the function of the outer bag and the inner bag is to seal in freshness (col. 2, ll. 19-22). Furthermore, the examiner only attempts to establish motivation by general statements, but does not give specific and particular reasons. See *In re Dembiczaik*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Although Theed does teach heat shrinking a bag around the loaf of bread to kill bacteria on the surface, we determine that this reference also does not provide "further motivation" to substitute a bag for the inner wrapping of Morris (Answer, page 5; see Theed, pages 2 and 11). The inner bag of Theed comprises shrink-wrap material which does not contain any perforations or partial weakenings but is removed by the consumer (Theed, pages 2 and 6). Theed teaches that perforations are only placed in the outer bag (abstract; pages 5 and 9). Accordingly, we find no convincing evidence or reasoning why one of ordinary skill in this art would have used the shrink wrap material taught by Theed in place of the inner wrapping material of Morris, which does contain perforations (see Morris, col. 3, ll. 15-19). We also note our

Appeal No. 2004-0996
Application No. 09/520,947

discussion above regarding the function of the inner wrap and outer bag as taught by Morris.¹

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the examiner has not established a *prima facie* case of obviousness in view of the reference evidence. Accordingly, we do not sustain any of the rejections on appeal.

¹The examiner has applied Collins and Blum to establish the obviousness of limitations recited in several dependent claims (Paper No. 8, page 5). Accordingly, we determine that Collins and Blum do not remedy the deficiencies in the examiner's rejections as noted above.

Appeal No. 2004-0996
Application No. 09/520,947

The decision of the examiner is reversed.

REVERSED

Thomas A. Waltz

THOMAS A. WALTZ)
Administrative Patent Judge)

Peter F. Kratz)
PETER F. KRATZ)
Administrative Patent Judge)
BOARD OF PATENT
APPEALS
AND
INTERFERENCES)

Beverly A. Pawlikowski)
BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

TAW/jrg

Appeal No. 2004-0996
Application No. 09/520,947

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347